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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

NKTR-46363

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Application Number

10/507,215

Filed

September 16, 2004

First Named Inventor

Inger-Margrethe Procida

Art Unit

1791

Examiner

Jeffrey Wolschlagier

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒ attorney or agent of record.
Registration number 39446☐ attorney or agent acting under 37 CFR 1.34.
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Signature

Nobuhiko Sukenaga

Typed or printed name

216-579-1700

Telephone number

April 5, 2010

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.

Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appln. No.	: 10/507,215	Conf. No.:	5563
Applicant	: Inger-Margrethe Procida et al.	Art Unit:	1791
Examiner	: Jeffrey Michael Wollschlager	Filed :	September 16, 2004
Title	: PROCESS FOR THE PRODUCTION OF A POLYMER LAYER OF A FLEXIBLE OFFSHORE PIPE AND A FLEXIBLE UNBONDED OFFSHORE PIPE		
Docket No.	: NKTR-46363	Cust No.:	00116

Mail Stop AF
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P.O. Box 1450
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants request review of the final rejection of claims 42-48, 53, 55-93, 100-105 and 117 in the above-identified application. No amendments are being filed with this request. A Notice of Appeal and Petition for Extension of Time accompany this request.

The pending claims were finally rejected under 35 U.S.C. 103(a). See the Office action dated December 3, 2009 (hereinafter, "the Office action"). In response to the final rejection, the applicant submitted Amendment "A" dated March 3, 2010. An Advisory action maintaining the rejection was mailed on March 11, 2010. An applicant-initiated interview occurred on March 25, 2010. The examiner and the applicant's attorney participated in the interview. The examiner and the applicant's attorney discussed the position set forth in the 3/11/2010 Advisory Action. The examiner maintained the position, but stated that he would consider written arguments in more detail. Those arguments are submitted herein.

An offshore pipe generally comprises one or more tube-formed barrier layers including an inner liner and at least one reinforcing layer. The inner liner is the innermost polymer layer. The polymer layer is generally cross-linked. However, the techniques used to perform the cross-linking step are often very cumbersome and time and space demanding. According to the

claimed invention, the polymer layer is cross-linked by infrared radiation comprising wavelengths corresponding to the absorption peaks for the polymer material. Therefore, a high degree of cross-linking can be achieved faster and using less space than the known processes, even if the pipe is thick.

Claims 42-48, 53, 55-93, 100-105 and 117 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sjoberg et al. (US 6,106, 761; hereinafter "Sjoberg") in view of Hardy et al. (US 5,918,641; hereinafter "Hardy") and either of Hirokazu et al. (US 3,513,228; hereinafter "Hirokazu") or Kent (US 2,528,523). Applicants respectfully request withdrawal of the rejection for at least the following reasons.

Regarding the amended claim 42, none of Sjoberg, Hardy, Hirokazu and Kent, alone or in combination, discloses, teaches or renders foreseeable that said cross-linking of said extruded polymer material is activated by application of infrared radiation comprising wavelengths corresponding to the absorption peaks for the polymer material.

The Office action states that Sjoberg teaches crosslinking the polymer mixture with infrared radiation. However, according to Sjoberg, the polymer material is irradiated with infrared radiation having wave lengths which differ from the wave lengths which are absorbed by the polymer material in question (Sjoberg; column 3, lines 17-19). This disclosure teaches away from the claim 42 invention which requires the application of the infrared radiation comprising wavelengths corresponding to the absorption peaks for the polymer material. Hardy, Hirokazu and Kent are silent about the wavelengths of the infrared radiation for cross-linking the polymer material.

In the Advisory Action, the examiner argues that the applicable wavelengths as set forth by Sjoberg are still within the scope of claim 42, as evidenced by several of the dependent claims. Applicants respectfully disagree, as discussed below.

The examiner argues that because the scopes of the dependent claims 76 and 79, 77 and 80 are 0.5-10 μm , 1.0-5.0 μm and 1.0-7.0 μm , the wavelengths as broad as 0.5-10 μm (claims 76, 79), 1.0-5.0 μm (claim 77) and 1.0-7.0 μm (claim 80) are understood to be within the scope of claim 42. This interpretation, however, ignores some limitations in claim 42. According to 37 C.F.R. §1.75, claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim. Because claims 76, 77, 79 and 80 depend from claim 42, the actual scopes of these dependent claims are not just "0.5-10 μm " (claims 76, 79), "1.0-5.0 μm " (claim 77) and "1.0-7.0 μm " (claim 80), but include the claim 42 limitation (the wavelengths corresponding to the absorption peaks for the polymer material) AND the above wavelength ranges. Therefore, not all of the wavelengths of 0.5-10 μm (claims 76, 79), 1.0-5.0 μm (claim 77) and 1.0-7.0 μm (claim 80) are within the scope of claim 42. Only the wavelengths corresponding to the absorption peaks for the polymer material in the ranges of 0.5-10 μm , 1.0-5.0 μm and 1.0-7.0 μm are within the scope of claim 42.

The examiner also argues that Sjoberg suggests avoiding the specific wavelengths of 3.2-3.6 μm and 6.7-6.9 μm , but also states that 1.2 μm is suited for the application and that 2-10 μm can also be employed. Even if this is true, Sjoberg does not meet all the claim limitations. As discussed above, only the wavelengths corresponding to the absorption peaks for the polymer material are within the scope of claim 42. Thus, the scope of claim 42 does not include 1.2 μm if 1.2 μm is not the absorption peak for the polymer material. It depends on whether 1.2 μm is the absorption peak or not. Therefore, Sjoberg's statement that 1.2 μm is suited for the application

does not show that Sjoberg teaches a wavelength within the scope of claim 42. Regarding 2-10 μm , Sjoberg clearly states that it may in some cases be simplest to entirely avoid the wave length range 2-10 μm within which most absorption peaks of polyethylene are located (Sjoberg; col. 6, lines 20-23). This statement indicates that 2-10 μm may not be employed because most absorption peaks of polyethylene are located within this range. Thus, the examiner's statement that 2-10 μm can also be employed is incorrect.

The examiner concludes based on his rationales that the phrase "wavelengths corresponding to the absorption peaks for the polymer material" has a somewhat different meaning in Sjoberg (it means 3.2-3.6 μm) than in the instant application (it can be broader than 0.5-10 μm). As discussed above, the scope of claim 42 is actually the wavelengths corresponding to the absorption peaks for the polymer material within 0.5-10 μm and thus cannot be broader than 0.5-10 μm . Therefore, the examiner's conclusion is incorrect.

Accordingly, the combination of Sjoberg, Hardy, Hirokazu and Kent does not meet all of the limitations of claim 42. Therefore, the asserted combination of Sjoberg, Hardy, Hirokazu and Kent does not render claim 42 obvious. Thus, withdrawal of the rejection as it applies to claim 42 is respectfully requested.

Claims 43-48, 53, 55-70, 76-77, 79-93, 100-105 and 117 which are directly or indirectly dependent from claim 42 should be allowable for at least the same reason as claim 42.

The same arguments apply to the other rejections against claims 49, 50, 94, 107, 110 and 111 under Sjoberg in view of Hardy and either of Hirokazu or Kent and further in view of Procida, and claim 78-81 under Sjoberg in view of Hardy and either of Hirokazu or Kent and further in view of Heino.

In addition, the examiner cited Heino in rejecting claims 78-81. Heino discloses that some wavelengths also match the characteristic oscillations of the polymer. However, the fact that some wavelengths match the characteristic oscillations of the polymer does not mean that there will be an absorption peak. There is no disclosure in Heino that the infrared radiation comprises wavelengths corresponding to the absorption peaks for the polymer material.


In summary, claim 42 recites wavelengths corresponding to the absorption peaks for the polymer material whereas Sjoberg specifically teaches wavelengths that differ from the wavelengths absorbed by the polymer material.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No.: NKTR-46363.

Respectfully submitted,

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